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APR 12 2007

In re Application of :
Durbin, et al. :
Application No. 09/681,017 :
Filed: November 22, 2000 :
Attorney Docket No. GEMS8081.023 :
For: METHOD AND SYSTEM TO REMOTELY
ENABLE SOFTWARE-BASED OPTIONS FOR
A TRIAL PERIOD

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition, filed March 26, 2007, under 37 CFR 1.183 to waive the necessity for the signatures of all joint inventors on 37 CFR 1.131 declarations.¹

The petition is **dismissed**.

37 CFR 1.131(a) states,

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

Petitioner requests the declaration under 37 CFR 1.131(a) be accepted without the signatures of two of the three inventors.

The Office has stated the signature requirements can be waived in certain circumstances.

- (1) The assignee or other party in interest can sign the affidavit or declaration if none of the inventors will sign the declaration. See MPEP 714.
- (2) The affidavit or declaration can be signed by fewer than all the inventors if the other inventors are deceased, refuse to sign, or are unavailable. The affidavit or declaration must show reduction to practice or conception of the invention coupled with due diligence by the non-signing inventors.

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. The instant petition is properly treated under 37 CFR 1.183.

Petitioner has failed to prove the two non-signing inventors are deceased, have refused to sign, or are unavailable. Therefore, the petition cannot be granted.

The Office notes the declaration signed by Winnie Durbin implies Zhang and Singh may not actually be joint inventors of the application. Durbin's declaration implies Zhang and Singh only contributed to the reduction to practice of the invention.

MPEP 2137.01(V) states,

Each joint inventor must generally contribute to the conception of the invention. A coinventor need not make a contribution to every claim of a patent. A contribution to one claim is enough. "The contributor of any disclosed means of a means-plus-function claim element is a joint inventor as to that claim, unless one asserting sole inventorship can show that the contribution of that means was simply a reduction to practice of the sole inventor's broader concept." Ethicon Inc. v. United States Surgical Corp., 135 F.3d 1456, 1460-63, 45 USPQ2d 1545, 1548-1551 (Fed. Cir. 1998) (The electronics technician who contributed to one of the two alternative structures in the specification to define "the means for detaining" in a claim limitation was held to be a joint inventor.).

Petitioner may wish to take steps to verify Zhang and Singh are properly listed as inventors.

Any request for reconsideration must prove the two non-signing inventors are deceased, have refused to sign declarations or cannot be found.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.183." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
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 401 Dulany Street
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Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3230.

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